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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,001	11/29/2001	Jack D. Taylor	KCX-387 (15828)	3912

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EXAMINER

VO, HAI

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/11/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,001

Applicant(s)

TAYLOR, JACK D.

Examiner

Hai Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 41-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 41-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

1. Claims 20-40 have been cancelled in the preliminary amendment received on 01/28/2003.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kaneko et al (US 5,445,862). Kaneko teaches a porous film comprising a polyurethane elastomer that includes a soft segment consisting of a polyether or a polyester and a hard segment

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consisting of a glycol and a diisocyanate and an inorganic filler and having a WTVR of 2000 g/m² – 24 hours (abstract, column 4, lines 59-62). Kaneko teaches the porous film has excellent flexibility, the strength at 50% elongation of 100-500 g/ 25 mm (column 6, lines 32-35). Likewise, it is clearly apparent that the porous film is elastic. Since Kaneko is using the same materials such as a thermoplastic polyurethane elastomer and an inorganic filler as Applicant to form a porous film as Applicant and the film of Kaneko itself is elastic and meets the specific range of WTVR set out in the claims, it is the examiner's position that the phase separation, stretchability, and elongation properties would be inherently present (see Applicant's specification, page 2, line 15 et seq.). Note In re Best 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made under 35 USC 102. In addition, the examiner wishes to point out that as the USPTO is unequipped to perform the necessary experimentation, the burden of showing the stretchability and elongation properties outside the instantly claimed range is shifted to Applicant.

With regard to claims 5 and 6, Kaneko teaches the film comprising a calcium carbonate filler in an amount of at least 50% by weight (column 5, lines 8, 33-35).

With regard to claim 11, Kaneko teaches the film having a thickness of 25 microns (column 10, line 29), which is correspondent to a basis weight of less than 100 gsm as set forth in the claim (specification, page 14, lines 21-27).

5. Claims 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al (US 5,445,862) in view of Haffner (US 6,207,237). Kaneko teaches an elastic, porous film can be used in diapers and feminine care products (column 3, lines 15-16). Haffner teaches an elastic, microporous film layer can be incorporated into a laminate such as a stretched-bonded laminate or a neck-bonded laminate (column 3, lines 40-45, column 6, lines 22-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a microporous film into the laminate motivated by the desire to provide a laminate excellent in flexibility, stretchability and moisture permeability.
6. Claims 1-4, 7-13 and 41 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ying et al (US 6,245,401). Ying teaches a multi-segmented film comprising an elastic film segment which is porous and formed from thermoplastic polyurethane elastomer and inorganic filler (column 8, lines 30-32; and column 10, line 15). Ying teaches the film segment having a WTVR of 3500 g/m² – 24 hours (column 8, line 67). Ying teaches the film segment can be laminated to one or more additional films (column 13, lines 5-10). Since Ying is using the same materials such as a thermoplastic polyurethane elastomer under the trade name ESTANE or MORTHANE and an inorganic filler as Applicant to form a porous film as Applicant and the film of Ying meets the specific range of WTVR set out in the claims and has a hysteresis within the range listed in the Tables 5 and 6 of the Applicant's specification (column 10, lines 61-64), it is the examiner's position

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that the hard segment, soft segment, phase separation, stretchability, and elongation properties would be inherently present (see Applicant's specification, page 2, line 15 et seq.). Note In re Best 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made under 35 USC 102. In addition, the examiner wishes to point out that as the USPTO is unequipped to perform the necessary experimentation, the burden of showing the stretchability and elongation properties outside the instantly claimed range is shifted to Applicant.

7. Claims 5, 6, 14-19, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ying et al (US 6,245,401). Ying is silent as to the amount of filler being added to the film segment. However, such a variable would have been recognized by one skilled in the art to control the degree of porosity of the film. As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the filler having an amount instantly claimed since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.
8. Claims 42, 43, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ying et al (US 6,245,401) in view of Haffner (US 6,207,237). Ying is silent as to a stretch-bonded laminate and necked-bonded laminate. Haffner teaches an elastic, microporous film layer can be incorporated into a

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laminate such as a stretched-bonded laminate or a neck-bonded laminate (column 3, lines 40-45, column 6, lines 22-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a microporous film into the laminate motivated by the desire to provide a laminate excellent in flexibility, stretchability and moisture permeability.


Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
January 30, 2003


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700